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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,100	12/20/1999	HENRY WHITFIELD	ADEX0001	8312

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EXAMINER

HUSEMAN, MARIANNE

ART UNIT PAPER NUMBER

2161

DATE MAILED: 04/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/472,100

Applicant(s)

WHITFIELD, HENRY

Examiner

Marianne Huseman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4, 5. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

In claims 6 and 21, line 3, there is no proper antecedent basis for "said entered private key".

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3 – 6, 8, 9, 11, 13 – 15, 16, 18 – 21, 23, 24, 26, and 28 - 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Franklin et al.

Regarding claims 1, 9, 15, 16, 24 and 30:

Franklin et al teach an electronic online commerce card such that Applicant's certificate authority reads on element 32 and column 9, lines 4 – 11, Applicant's virtual certificate reads on the electronic online commerce card, Applicant's redemption denomination reads on the customer's credit/debit limit, Applicant's first public key identifier reads on the inherent public key which would correspond to the assigned private key, column 2, lines 17 – 19 and column 8, lines 21 – 24, Applicant's certificate issuance module reads on the software module used to formulate transaction numbers, Applicant's certificate including redemption denomination and first public key identifier reads on the customer's credit card/debit card and column 8, lines 21 – 24, respectively, Applicant's storing of redemption denomination, first public key identifier and private key

reads on the customer database, element 62, Applicant's authenticating module reads on the issuing institution and column 2, lines 51 – 55, and Applicant's canceling means reads on the inherent rejection of the authorization request if the customer data in the request is not correct.

Regarding claims 3 and 18:

Applicant's payment agent reads on the customer's credit/debit card which corresponds to the customer account number.

Regarding claims 4, 5, 19 and 20:

The customer's supplying of his credit/debit card account numbers is considered authorization.

Regarding claims 6 and 21:

Applicant's means to deliver reads on the operation of element 42, particularly elements 58 and 50. See column 5, lines 24 – 40.

Regarding claims 8 and 23:

Applicant's electronic form reads on the electronic online commerce card, column 4, lines 66 – 67 continuing at column 5, line 1.

Regarding claims 11 and 26:

Applicant's entering said assigned private key reads on the subsequent action of the software module upon the customer entering a password.

Regarding claims 13 and 28:

Applicant's user unique assigned private key reads on the unique private key disclosed at column 2, lines 16 – 18.

Regarding claims 14 and 29:

Applicant's private acquirer facility access key reads on the private key of Franklin et al and the disclosure at column 2, lines 50 – 64.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 10, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al.

Regarding claims 2 and 17:

Franklin et al teach a password, chosen by the customer, at the time of registration such that the customer is required to enter the password in order to begin an online transaction. The entered password is compared to the earlier chosen password and if correct access to the private key is granted. Although Franklin et al does not specifically teach that the password is stored at a certificate authority, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to have the certificate authority (or whomever issues the certificates) store the password in case the customer should forget the password. This procedure is usually an option on any system that is password protected wherein upon entering an incorrect password the customer is asked to give i.e., the customer's mother's maiden name or some other secondary hint, and the certificate authority/system would then supply the password.

Regarding claims 10 and 25:

Although Franklin et al do not disclose that an alternate recipient may be a holder of a certificate and submit the private key, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention for the customer taught by Franklin et al to inform i.e., a spouse or other responsible person of the customer's password and hence private key so that the spouse would also be able to use the same system for making purchases on-line rather than having two separate accounts/modules.

6. Claims 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al in view of Lee et al.

Although Franklin et al do not disclose the "physical" generation of a certificate, Lee et al, figure 1, teach self-authenticating negotiable documents such that a physical certificate is generated by a user/customer for payment of off-line transactions. This certificate includes a bar code, element 110, containing information similar to the information contained in Franklin et al's virtual certificate, such as amount of check

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(denomination), hash code, public key, and account number. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the teachings of Lee et al in the system of Franklin et al so that a physical form of a certificate can be used in off-line transactions.

7. Claims 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al in view of Larsson et al.

Although Franklin et al do not teach generating a new key for each issued certificate, Larsson et al teach smart card device wherein with each new certificate, a new private key is generated. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize generating new keys with each new certificate/transaction as this would increase the security of the certificate; making it less likely for another to forge a certificate.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nickles, Snyder et al., Holloway and Scheinert each teach using a new key for each transaction.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne Huseman whose telephone number is 703-605-4277. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

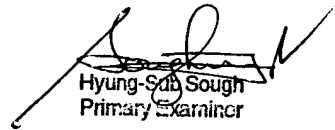
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10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700.



Marianne Huseman
Examiner
Art Unit 2161

mh
April 8, 2002



Hyung-Soo Sough
Primary Examiner